

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 17-22, 24, 25, 27 and 28 are requested to be cancelled. Claims 1-16, 23, and 26 are currently being amended.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

In the Office Action, claim 15 was rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement. By this Amendment, claim 15 was amended to recite that the “memory stores the information related to the piece of merchandise as the bookmark in units of digital copying machines capable of displaying advertisements of merchandise.” Support for this language is provided, for example, page 16, lines 14-24, of the specification. Accordingly, Applicants submit that claim 15 is in conformance with 35 U.S.C. § 112, ¶ 1.

Claims 19, 22, and 25 were rejected under 35 U.S.C. § 112, ¶ 2. This rejection is moot in view of the cancellation of claims 19, 22, and 25.

Claims 1, 2, 4-7, 9, 17-19, and 23-25 were rejected under 35 U.S.C. § 102(b) as being anticipated by the recommend-it.com website. Claim 1, as amended, recites that a digital copying machine comprises a display device that displays an advertisement of merchandise, a mail button that instructs the digital copying machine to transmit an e-mail message that includes information related to the piece of merchandise of the advertisement displayed by the display device, an input device that inputs a recipient of the e-mail message for which transmission is instructed by the mail button, and a mail transmission device that, when the mail button is pressed, transmits the e-mail message having the information of the piece of merchandise, including link information linked with a site on the Internet where the piece of

merchandise is on sale, from the digital copying machine to the recipient input by the input device.

In contrast to claim 1, there is nothing in the recommend-it.com materials that discloses or suggest that its system could be implemented on a digital copying machine. Rather, the recommend-it.com materials merely discloses a system in a general network where each user employs a PC, not a digital copying machine as required by claim 1. Accordingly, claim 1 is patentably distinguishable from the recommend-it.com materials.

Claims 2, 4-7, and 9 are patentably distinguishable from the recommend-it.com materials by virtue of their dependence from claim 1, as well as their additional recitations. Claim 23 is patentably distinguishable from the recommend-it.com materials for reasons analogous to claim 1.

Claims 10-12, 15, and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by America Online Tour Guide Version 3 in 1996 (AOL Guide). Claim 10 recites that a digital copying machine comprises a display device that displays the advertisement of merchandise, a memory that stores, as a bookmark, information related to the piece of merchandise displayed by the display device, a registration button that instructs the digital copying machine to register the information related to the piece of merchandise as the bookmark in the memory when the advertisement of the piece of merchandise is being displayed on the display device, and a transmitter that, upon being accessed from an external device, transmits the information related to the piece of merchandise registered in the memory as the bookmark to the external device as data displayable on the external device, the data displayable on the external device containing link information linked with a site on the Internet where the piece of merchandise is on sale.

In contrast to claim 10, like the recommend-it materials, there is nothing in the AOL Guide that discloses or suggest that its system could be implemented on a digital copying machine. Rather, the AOL Guide merely discloses a system in a general network where each user employs a PC, not a digital copying machine as required by claim 10. Accordingly, claim 10 is patentably distinguishable from the AOL Guide. Claims 11-12, 15, and 16 are

patentably distinguishable from the AOL Guide by virtue of their dependence from claim 10, as well as their additional recitations.

Claims 3 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the recommend-it.com materials in view of Official Notice. Regardless of the propriety of the Official Notice or the combinability of the Official Notice with the recommend-it.com materials, claims 3 and 8 are patentably distinguishable from the combination of the recommend-it.com materials in view of Official Notice by virtue of their dependence from claim 1, as well as their additional recitations.

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the AOL Guide in view of Official Notice. Regardless of the propriety of the Official Notice or the combinability of the Official Notice with the AOL Guide, claims 13 and 14 are patentably distinguishable from the combination of the AOL Guide in view of Official Notice by virtue of their dependence from claim 1, as well as their additional recitations.

Claims 20-22 and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the AOL Guide in view of the Citibank article. Claim 26, as amended, recites that an advertisement method of providing an advertisement of merchandise operable on a digital copying machine that provides an advertisement of merchandise to be sold on the Internet comprises displaying the advertisement of merchandise on a display device of the digital copying machine, storing, as a bookmark, information related to the piece of merchandise displayed on the display device in a memory of the digital copying machine, and in accordance with an access from an external device, transmitting the information related to the piece of merchandise registered in the memory as the bookmark from the digital copying machine to the external device as data displayable on the external device, the data displayable on the external device containing link information linked with a site on the Internet where the piece of merchandise is on sale, and the link information containing information representing a presenter of the piece of merchandise.

Like the AOL Guide, there is nothing in the Citibank article that discloses or suggest implementing the method on a digital copying machine. Rather, both the AOL Guide and the

Citibank article merely disclose a system in a general network where each user employs a PC, not a digital copying machine as required by claim 26. Accordingly, even if combinable, claim 26 is patentably distinguishable from the combination of the AOL Guide and the Citibank article. Claims 11-12, 15, and 16 are patentably distinguishable from the AOL Guide by virtue of their dependence from claim 10, as well as their additional recitations.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 3/3/06

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